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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,998	04/14/2004	Julia Billiard	2004658-0047 (AM101291)	7072

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Patent Department
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EXAMINER	
XIE, XIAOZHEN	
ART UNIT	**PAPER NUMBER**
1646	

MAIL DATE	DELIVERY MODE
12/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/823,998	**Applicant(s)** BILLIARD ET AL.	
	Examiner Xiaozhen Xie	**Art Unit** 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *20,23,25,27,94 and 96*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

    _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement (the new matter rejection)..

Continuation of 13. Other:
Applicant's amendment of the claims fails to overcome the rejection under 35 U.S.C. 102(b) as being anticipated by Clary (WO 98/457080) for reasons set forth in the previous office action. Applicant amended claim 20 to add step "(c) identifying the agent as having bone-related activity if a decrease or an increase in Ror activity is detected". Applicant argues that since Clary is silent on any connection between Ror family members and bone metabolism, Clary cannot possibly teach or even suggest such a step. However, the claims still read on two action steps: a) combining an agent with a Ror molecule; and b) detecting an effect of said agent on Ror activity; the agent is identified as having bone-related activity if a decrease or an increase in Ror activity is detected (i.e., step c is a result of the steps a and b, step c does not read on an action step). Clary teaches a method of identifying one or more compounds that modulate the function of a RPTK (such as Ror2) in a cell, wherein the method comprises the same action steps. It would have been inherent that the identified agent is a "bone-related agent".

Claims 25 and 27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Clary, in view of Oishi et al.
Applicant argues that neither reference teaches or suggests any connection between an Ror family member and bone metabolism, and that the two references even in combination cannot render obvious the claimed invention because neither reference teaches the newly added step c. As set forth above, step c is a result of the steps a and b (i.e., the agent is identified as having bone-related activity if a decrease or an increase in Ror activity is detected), and it does not read as an action step.

Claims 20, 23, 25, 27, 94 and 96 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Godowski et al. (U. S. Patent No: 5,766,863), in view of Oishi et al. Applicant argues that neither reference teaches or suggests any connection between an Ror family member and bone metabolism, and that the two references even in combination cannot render obvious the claimed invention because neither reference teaches that the modulators of Ror are bone-related agents. Applicants' argument has been fully considered but has not been found to be persuasive. Even though Godowski and Oishi are silent on any connection between an Ror family member and bone metabolism, it is inherent that the identified agent is a "bone-related agent", because the two reference, when combined, render the claimed method obvious (i.e., teach or suggest the same method steps as the claimed invention).

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PRIMARY EXAMINER